

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

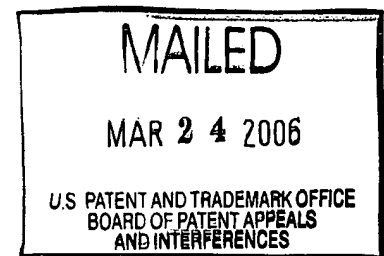
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIHARU KURODA and TAKASHI YAMAGATA

Appeal No. 2006-0279
Application No. 08/942,415

HEARD: FEBRUARY 8, 2006



Before THOMAS, JERRY SMITH and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-13 which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to an image recording device which occupies a smaller space compared to conventional devices and has a multi-purpose tray arranged horizontally in the space between a document sheet outlet tray and a recording sheet supply cassette unit. According to Appellants, using a flap-type

tray as the multi-purpose tray in conventional devices does not allow stacking a large number of sheets and requires sufficient space around the device for the tray to project from the side of the recording device (specification, page 2). An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced below:

1. An image recording device having a top, a bottom and a width, comprising:

a main body including:

a recorded paper discharge tray provided at the top of the image recording device;

a document sheet supply tray provided below the recorded paper discharge tray for holding a document sheet;

a document sheet outlet tray provided below the document sheet supply tray for receiving the document sheet;

a base having an upper surface; and

a multi-purpose tray formed on said upper surface of said base and below the document sheet outlet tray for holding recording sheets, wherein a user loads said recording sheets directly onto said multi-purpose tray;

a recording sheet supply part provided below said main body and independent of said multi-purpose tray for holding a plurality of stacked recording sheets and supplying a recording sheet one page at a time, said recording sheet supply part includes a paper cassette which is attachable to and detachable from said image recording device, said paper cassette capable of being manually loaded;

an image scanner that transports the document sheet from the document sheet supply tray, scans an image on the document sheet and discharges the document sheet onto the document sheet outlet tray; and

Appeal No. 2006-0279
Application No. 08/942,415

a recording part that transports the recording sheet from the recording sheet supply part or the multi-purpose tray, records an image on the recording sheet and discharges the recording sheet onto the recorded paper discharge tray, with the recorded paper discharge tray, the document sheet supply tray, the documents sheet outlet tray and the multi-purpose tray being confined within the width of the image recording device.

The Examiner relies on the following references:

U.S. Patents

Kitazawa	5,078,380	Jan. 7, 1992
Kojima et al. (Kojima)	5,412,490	May 2, 1995
Ono	5,796,496	Aug. 18, 1998

Published European Patent application

Sakaue et al. (Sakaue)	0 673 147 A2	Sep. 20, 1995
------------------------	--------------	---------------

Claims 1-3, 6-8, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kojima, Ono and Kitazawa.

Claims 4, 5, 9, 10 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kojima, Ono, Kitazawa and Sakaue.

We make reference to the answer (mailed April 15, 2004) for the Examiner's reasoning and to the appeal brief (filed February 10, 2004) and the reply brief (filed June 3, 2004) for Appellants' arguments thereagainst.

OPINION

The focus of Appellants' arguments is that all of the references fail to teach or suggest that the multi-purpose tray is confined within the width of the image recording device, as recited in claim 1 (brief, page 9). Appellants further point out

that, as defined in the specification (page 5, lines 20-23) and depicted in Figure 1, the width direction coincides with the transport direction of the document and recording sheets (id.). Additionally, Appellants argue that the Examiner's interpretation of the "width" in the claimed multi-purpose tray being confined to the longitudinal sides of the device body is contrary to the disclosed embodiments which require that the tray not project from the lateral sides of the device in order to save space (reply brief, page 4).

In response to Appellants' arguments, the Examiner asserts that the multi-purpose tray 25 of Kitazawa is confined within the width of the copier considering the side that includes tray 25 as the width of the copier while the side that includes cassettes 19a-d is the length (answer, page 9). Furthermore, to support the assertion, the Examiner provides the drawing of a representation of the copier designating the side edge as the "width" and the longitudinal edge as the length (answer, page 10).

Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline
Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988). Our reviewing court

has also established that the words in claims should be defined as they are disclosed in the specification before resorting to their dictionary definitions, Phillips v. AWH Industries, 415 F.3d 1303, 1326, 75 UAPQ2d 1321, 1335 (Fed. Cir. 2005) (en banc). Similarly, although "width" could generally refer to any of the lateral or frontal sides of the device, we first must refer to the disclosure for its definition. As such, in determining the scope of claim 1, we will rely on the words of the claim consistent with the disclosure to determine whether this limitation constrains the claim to a device having a width in any direction or a specific direction as outlined in Appellants' specification.

Here, Appellants limit the term "width" in their specification to a direction which coincides with the transport direction of the document and recording sheets (page 5) such that the claimed multi-purpose tray does not project from the lateral sides of the device (page 12) which contributes to space saving. Therefore, the claims are limited by the way the term "width" is defined with respect to the specific orientation of the device described in the specification.

Upon a review of Kitazawa, we remain unpersuaded by the Examiner's reasoning in characterization of the side including the tray 25 as the claimed width. The side that the Examiner identifies as the width does not coincide with the transport direction of the document and recording sheets in the copier and

instead, is perpendicular to such direction (Figures 1 and 2). Kitazawa, in fact, shows that the tray 25 is confined within the lateral side of the copier (Figure 1) whereas a part of it protrudes from the lateral side beyond the width, which is defined by the other side where the trays 19a-19d are shown. Similar to Kitazawa, tray 94 of Ono is confined within a lateral dimension of the copier and may not be properly characterized as the claimed multi-purpose tray which is required to be confined within the width of the copier.

Based on our findings above, we also agree with Appellants (reply brief, page 5) that the applied references neither disclose nor teach that any of the trays are confined within the width of the device. Therefore, by merely speculating and arbitrarily defining the width as the lateral side of the copier, there cannot be any reasonable teaching or suggestion for combining the applied prior art. Accordingly, as the Examiner has failed to establish a prima facie case of obviousness, we do not sustain the rejection of claims 1-3, 6-8, 11 and 12 over Kojima, Ono and Kitazawa.

With respect to the rejection of the remaining claims, the Examiner further relies on Sakaue for teaching the specific orientation of the copier with respect to the user operating the copier. However, nothing in this additional reference, alone or in combination with Kojima, Ono and Kitazawa, overcomes the deficiencies discussed above with respect to claim 1.

Appeal No. 2006-0279
Application No. 08/942,415

Therefore, the 35 U.S.C. § 103 rejection of claims 4, 5, 9, 10 and 13 over Kojima, Ono, Kitazawa and Sakaue cannot be sustained.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-13 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge

MAHSHID D. SAADAT
MAHSHID D. SAADAT
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2006-0279
Application No. 08/942,415

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW SUITE 700
WASHINGTON, DC 20036